UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY D. SHEELY

Appeal No. 2005-1397
Application No. 10/024,311

ON BRIEF

Before WALTZ, KRATZ and TIMM, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-12, which are all of the claims pending in this application.

BACKGROUND

Appellant's invention relates to a reinforced tape that includes a visually transparent polymeric backing layer, a fibrous reinforcing scrim along a second major surface of the backing layer, and a layer of visually transparent adhesive covering said reinforcing scrim with only portions of the scrim being wetted by the adhesive so as to leave the reinforcing scrim visible along the backing layer. The fibers of the scrim and

transparent adhesive possess indexes of refraction that are similar such that upon application of force to the backing to press the layer of adhesive against a substrate, the adhesive layer will wet the fibers resulting in a significantly less visible scrim after the pressing against the substrate than before the pressing occurred. According to appellant, this results in a reinforced tape that visibly assures a user of the tape reinforcement or strength prior to use; yet, allows for a pleasing appearance after use, as the scrim becomes less visible upon application to a substrate. See page 2, lines 26-32 of appellant's specification. A further understanding of the invention can be derived from a reading of exemplary claim 1[1], which is reproduced below.

> 1. A length of reinforced tape comprising:
> an elongate visually transparent backing layer of polymeric material having opposite longitudinally extending edges and opposite first and second major surfaces;
> a reinforcing scrim along the second major surface of said backing layer, said reinforcing scrim being formed of fibers; and
> a layer of visually transparent adhesive along said second layer major surface of said backing layer and covering said reinforcing scrim with only portions of said reinforcing scrim being wetted by the adhesive

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[1] Prior to final disposition of this application, the examiner and appellant should determine whether or not the term "said polymer fibers" (claim 1, fourth paragraph) has appropriate antecedent support.

so that the reinforcing scrim is visible along the backing layer;

said polymeric fibers and said transparent adhesive having similar indexes of refraction so that upon applying force to the backing to press the layer of adhesive against a substrate the layer of adhesive will wet the fibers, causing the reinforcing scrim to become significantly less visible than before the reinforced tape was adhered to the substrate.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Serra et al. (Serra)	5,407,726	Apr. 18, 1995
Perez et al. (Perez)	6,331,343	Dec. 18, 2001 (filed May 07, 1999)

Claims 1 and 6-12 stand rejected under 35 U.S.C. § 102(b) as anticipated by, or, in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over Serra. Claims 2-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Serra in view of Perez.

We refer to the brief and reply brief and to the answer for a complete exposition of the opposing viewpoints expressed by appellant and the examiner concerning the issues before us on this appeal.

OPINION

Upon careful review of the entire record including the respective positions advanced by appellant and the examiner with respect to the rejections before us, we find ourselves in

agreement with appellant's viewpoint since the examiner has failed to carry the burden of establishing that the herein claimed subject matter would have been anticipated under 35 U.S.C. § 102(b) or obvious within the meaning of 35 U.S.C. § 103(a) over the applied prior art. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1471-1472, 223 USPQ 785, 787-788 (Fed. Cir. 1984).

To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). As stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting Hansgirg v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)) (internal citations omitted):

> Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

Here, the examiner acknowledges that Serra does not "explicitly teach the claimed index [of] refraction of the fibers and adhesive or the percentage of reflected light before and

after adhering the tape to a substrate" (answer, page 3).

Rather, the examiner maintains (answer, page 3) that:

> it is reasonable to presume that these properties [are] inherent to the Serra et al. invention. Support for this presumption is found in the use of like materials (i.e. polyester or cotton nonwoven scrims, polyethylene backing layers, and adhesive layers). The burden is upon Applicant to provide otherwise. In addition, the presently claimed property of the index of refraction of the material of the fibers being within plus or minus 0.2 of the index of refraction of the adhesive and the percentage of light being reflected from the tape . . . was reduced . . . by adhering the tape to the substrate would obviously have been present once the Serra et al. product is provided.

However, the examiner has not established how Serra's disclosure of some overlapping materials supports the examiner's presumption.

In this regard, the examiner also takes the position (answer, page 5) that:

> Serra et al. teach that the adhesive layer is present in the interstices of the scrim. Therefore, the Examiner is equating the interstices of Serra's scrim to the portions of the scrim in Appellant's invention that are wetted by the adhesive.

However, as explained by appellant in the briefs, the mere fact that Serra (column 3, lines 28-30) state that "a portion of the adhesive layer will be present in the interstices of the scrim" does not serve as a description of "only portions of the reinforcing scrim being wetted by the adhesive" in a manner as

required by sole independent claim 1. In particular, the examiner has not fairly explained how Serra necessarily describes the production of a tape having the required similar indexes of refraction of the adhesive and the fibers while employing a partial wetting of the scrim such that the tape has the property that upon pressing the adhesive layer of the tape against a substrate, the layer of adhesive will wet the fibers and thereby significantly reduce the visibility of the reinforcing scrim as compared to the visibility of the scrim before the tape was adhered to the substrate.

Moreover, the examiner has not offered a reasonable basis to explain how the teachings of Serra reasonably are suggestive of the claimed tape so as to render the claimed tape obvious, within the meaning of 35 U.S.C. § 103. In this regard, we recognize that Serra teaches that the adhesive employed can be a pressure sensitive adhesive and may be optionally be selected to be an acrylic adhesive as referred to at column 2, lines 41-44 of the patent. Moreover, we are cognizant that Serra (column 3, lines 19-27) teaches that a woven or non-woven scrim can be employed in the tape, including a preferred woven scrim of up to 50% cotton in the warp direction. However, the examiner has not fairly explained how that disclosure of Serra inherently describes or

obviously suggests selection of a particular acrylic adhesive and a particular scrim material together with using a partial wetting of the scrim by the adhesive in forming the tape, such that the indexes of refraction of the scrim and adhesive are so similar and the adhesive wetting is such that the tape has the property of possessing a significantly reduced visibility upon being adhered to a substrate.

It follows that, on this record, we will not sustain the examiner's anticipation or obviousness rejection over Serra.

Concerning the examiner's § 103(a) rejection of dependent claims 2-5 over Serra in view of Perez, the examiner does not offer any explanation as to how Perez would make up for the above-noted deficiencies in the stated rejection of independent claim 1. Rather, the examiner relies on Perez to allegedly establish the obviousness of the additional claimed features as set forth in dependent claims 2-5. Because those dependent claims 2-5 also include all of the limitations of claim 1, it follows that we shall also reverse the examiner's § 103(a) rejection of dependent claims 2-5 on this record.

CONCLUSION

The decision of the examiner to reject claims 1 and 6-12 under 35 U.S.C. § 102(b) as anticipated by, or, in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over Serra and to reject claims 2-5 under 35 U.S.C. § 103(a) as being unpatentable over Serra in view of Perez is reversed.

REVERSED

THOMAS A. WALTZ
Administrative Patent Judge)
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PETER F. KRATZ) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
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CATHERINE TIMM)
Administrative Patent Judge)

PFK/sld

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